

## **REMARKS**

The present amendment is submitted as a response to a final office action issued August 18, 2008 and to an advisory action and oral communication between applicant's representative and the Examiner. In that interview, applicant's representative made substantially the same arguments given below for patentability of the unamended claims.

The application consists of claims 1-5 and 7-22, of which claim 1 and 16 are the only independent claims. Claims 1, 2-5 and 7-13 and 15 are amended herewith as detailed below. Claims 16-22 are new method claims

### **Claim Objections**

Claims 1, 3-5, 7-12 and 15 stand objected to since the term "heat-generating elongate element" should read "heat-generating elongated element". Applicants have amended the term in the claims to overcome the objection and expedite prosecution.

### **Claim Rejections – 35 USC 112**

Claim 15 stands rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement and with the enablement requirement since there is no disclosure to the "adjuster mechanism" being responsive to motion detected by the motion detector. Applicants have removed the rejected feature from the claim and added a feature to the controller of claim 1 as follows "wherein the controller is operative to control, responsive to motion detected by said motion detector, said heat generating elongated element to prevent heat from being applied continuously in a single area for sufficient time to cause skin damage." Support for this amendment is found at least on page 2, lines 11-19 and page 13, lines 3-20 of the International Publication.

Claims 1-15 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner rejects the recitation in claim 1 of "a heat generating elongate(d) element situated in the opening, positioned with respect to the opening such that, in operation, the heat generating elongate(d) element can touch the skin, and capable of producing heat sufficient to cut hair, when electrified" since it is unclear or uncertain to the Examiner how the heat element does not burn the user when it can touch the skin and requires further clarification to structural limitations.

Applicants respectfully disagree with the rejection and submit that the claim already recites the required structural limitations. However, in order to advance prosecution the claim has been amended to include the limitation of: "a controller for controlling the heat generating elongated element to prevent heat from being applied continuously in a single area for sufficient time to cause skin damage." Applicants submit that the claim fully meets the requirements of 35 U.S.C. §112. Support for this amendment is found at least on page 2, lines 11-19 and page 13, lines 3-20 of the International Publication.

One aspect of the invention is an apparatus having a heat element juxtaposed to the skin without burning the skin. The inventors have found that this can be performed since the skin has a higher heat capacity as opposed to the hair. In addition, the mass of skin underlying the surface is large so that the heat is carried away to this large mass and the heating of the skin is much lower than that of the hair. Therefore, it is possible to apply the same amount of heat to the skin and hair such that the hair temperature will raise enough to burn while the skin will not be damaged. Since the device is designed to be used as a usual home shaver it is of course necessary to provide controlling means for the heat supplied to the skin in order ensure that it will not exceed the heat capacity of the skin while still burning the hair.

The inventors have found a number of ways to avoid damage to the skin surface and filed a number of applications to different embodiments.

Claim 1 recites "a) at least two rows of elongate skin depressing elements, a space between the ends of said elements defining an opening in the head; b) a heat generating elongated element situated in the opening..." Applicants refer to page 11, lines 29-33 of the International Publication where it is described how the skin depressing elements assist in avoiding the heat generating element to sink into the skin thereby preventing skin damage:

"As shown more clearly in Fig. 3, in an exemplary embodiment, compartment 300 comprises a row of skin-depressing elements 312. Skin-depressing elements 312 serve to depress and/or tighten area of skin 400 (Fig. 4), allowing heat-generating wire 260 to cut hair 404 without sinking into skin 400 and possibly dissipating its heat so that it cuts less efficiently and/or burns skin 400."

Applicants note that additional applications were filed by applicants for electric shavers, claiming various features, such as for example, PCT publications WO

03/009977 and WO 03/009976. These features are designed to avoid burning of the skin by an elongate element that cuts the hair by heat.

Thus, while applicants have amended the claims, applicants believe that the amendment is not necessary.

The recitation "one or more position adjuster mechanisms juxtaposed between the frame and the base" stands rejected under 35 USC §112, second paragraph, since if the recitation "one or more position adjuster mechanisms" includes "one", the Examiner queries applicant how it can be juxtaposed when it is a single element. Applicants have amended the recitation to now read "one or more position adjuster mechanisms mounted between the frame and the base" in order to remove any doubt as to the clarity of the claim.

#### **Claim Rejections – 35 USC §102 and §103**

Claims 1, 3, 8, 10 and 14 stand rejected under 35 USC §102(b) as being anticipated by Peterson (US 2,231,219).

Claims 1-5, 7, 8, 10 and 14 stand rejected under 35 USC 102(b) as being anticipated by Johnson (US 3,093,724).

Claim 2 stands rejected under 35 USC 103(a) as being unpatentable over Peterson.

Claims 4, 5 and 7 stand rejected to as being unpatentable over Peterson in view of Johnson.

Claims 9 and 11 stand rejected under 35 USC 103(a) as being unpatentable over Peterson in view of Hashimoto (US 5,064,993).

Claims 12 and 13 stand rejected under 35 USC 103(a) as being unpatentable over Peterson in view of Parker (US 6,481,104).

Claim 15 stands rejected under U.S.C. 103(a) as obvious over Peterson in view of Tse et al (US 6,452,501) and Shibuya (JP 11156800).

Claim 15 stands rejected under U.S.C. 103(a) as obvious over Peterson in view of Johnson and Shalev et al (WO 03/009976).

Claim 15 stands rejected under U.S.C. 103(a) as obvious over Johnson in view of Tse et al and Shibuya.

Claim 15 stands rejected under U.S.C. 103(a) as obvious over Peterson in view Shalev.

In his rejections, the Examiner states that the feature in claim 1 of the heat generating elongated element being positioned "such that, in operation, the heat generating elongated element can touch the skin" is deemed intended use. Accordingly, the Examiner ignored the feature when rejecting the claim.

Applicants respectfully disagree with the Examiner. However, to advance prosecution, applicants have amended claim 1 to avoid the rejection. Applicants have also added a set of method claims which completely avoid any question of intended use.

For the record, applicants submit that the heat element being positioned "such that, in operation, the heat generating elongated element can touch the skin" is a structural and not an intended use limitation. The feature defines how the heat element is positioned, i.e., in the opening, but not so far into the housing such that in use it can not touch the skin. This can be seen as a structural limitation defining how the heat element should be positioned with respect to the skin. In Peterson, for example, this feature is not met in a structural sense. The heat element is positioned in such a manner that it will not, under any circumstances, touch the skin, see col. 2, lines 24-26 "...so that the wire 3 *will not touch the skin* but will provide for severing hairs in close proximity to the skin." (emphasis added).

Also Johnson's device is specifically structured to avoid having the wire touch the skin. Johnson describes a comb type device having two sets of teeth, the teeth of one set being shorter than those of the other set, in which the longer tines of the comb may touch the scalp. The sets of teeth are placed apart by a longitudinal slot in which a wire blade is positioned. In order to avoid burning of the skin, the device of Johnson has one set of teeth longer than the other set, so as to ensure that the longer set of teeth touches the skin and the wire blade which is positioned in the opening does not contact the skin.

Thus, it is submitted that the structure claimed in claim 1 before amendment is novel and non-obvious over the cited art.

Regarding the Peterson reference, applicants have argued in their previous response that Peterson does not teach nor suggest "each of the skin depressing elements has a long axis pointed generally toward the center of the opening" as recited in independent claim 1. The Examiner disagrees with this argument on page 22 of the present action and states that Peterson shows tapered teeth elements 1 and 2 having end portions pointed generally towards slot 3. Applicants respectfully point out that

Peterson does not show any tapered teeth elements and that numeral references 1 and 2 represent a handle and tubular member. In addition, numeral reference 3 represents a wire and not a slot as indicated by the Examiner. It seems to applicants that the Examiner has confused the Peterson reference with the Johnson reference. In any case, applicants repeats their argument that Peterson does not show "each of the skin depressing elements has a long axis pointed generally toward the center of the opening" as recited in independent claim 1.

However, again to advance prosecution, applicants have amended claim 1 to overcome the Examiner's rejection and submit that the new wording describing the skin depressing elements overcomes all of the Examiner's arguments.

As to the new method claims, applicants submit that even if the Examiner finds that the apparatus claims are unpatentable in view of the prior art, the method claims describe a methodology of use of the apparatus that is completely different from that of the prior art.

In view of the above amendment and arguments, applicants submit that the claims are patentable over the cited art. Applicants intend to schedule an interview with the Examiner after filing the response in order to discuss the above arguments.

Respectfully submitted,



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**Enclosures:**

- Petition for Extension (Two Months)
- Request for Continued Examination (RCE)